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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,131

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action (in Paper No. 13) has been withdrawn pursuant to 37 CFR 1.114.

Election/Restriction

2. Applicant's election of Species A (claims 1-22) in Paper No. 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. The Examiner again notes that currently Invention Group I (claims 1-11) is not patentably distinct from Invention Group II (claims 12-22). A restriction between the inventions at this time would be improper. Applicant is again reminded that should future amendments make the claims patentably distinct or if Applicant argues the claims *are* patentably distinct, a restriction between the two inventions may follow.

The Examiner realizes that certain claim interpretation doctrines may apply to one group of claims and not the other. Nevertheless, this does not cause the current groups of claims to be

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patentably distinct. If however Applicant believes these doctrines cause the respective groups of claims to be patentably distinct, Applicant is requested to expressly make this statement. If Applicant admits that the groups of inventions are patentably distinct, a restriction between the two inventions may follow.

Acknowledgments

4. The amendment filed June 24, 2003 (Paper No. 16) is acknowledged. Accordingly, claims 1-22 remain pending.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 12-22, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Ogasawara (U.S. 6,123,259). Ogasawara discloses the following: a UPC code (column 11, last paragraph); an extraction circuit (within scanner 15); a temporary buffer

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(inherent in any CPU); an identification device (device that identifies the product scanner); a retail processing system (inherent); ownership of the article is transferred after receiving encoded information (and payment); the scanner has a unique id (column 10, paragraph starting on line 25); the personal scanner is wireless (wireless to the main store server 50 and its database); the user has an account set up for them prior to receiving the scanner (inherent); the scanner has at least some memory (which is a temporary buffer).

7. Claims 1-5 and 12-16, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barnett (U.S. 6,343,276).

8. Claims 1-11, as understood by the Examiner, are also rejected under 35 U.S.C. 102(e) as being anticipated by Ogasawara. It is the examiner's position that Ogasawara anticipates the claimed method because the method is inherently disclosed. The rationale for this inherency is that the prior art device, in its normal and usual operation, would necessarily perform the claimed method. See MPEP §2112.02.

9. The Examiner notes that Applicant has declined the Examiner's express invitation¹ to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Furthermore, because of the ambiguity in Applicant's response regarding this issue (see e.g. "Remarks", page 6), a telephone call was placed to Applicant's representative, Mr. Gregory M. Howison requesting clarification. On or about

¹ See the Examiner's previous Office Action, Paper No. 9, Paragraph No. 16 mailed April 23, 2002.

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October 1, 2002, Mr. Howison in a telephonic conversation with the Examiner informed the Examiner that Applicant intended NOT to be his own lexicographer. Confirmation of Applicant's position is respectfully requested in Applicant's next response. Therefore, for due process purposes, the Examiner gives notice that for the remainder of the ex parte examination process, the presumption in favor of the ordinary and accustomed meaning is maintained and is now made final. The claims are therefore interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).² The Examiner now relies heavily on this interpretation.³ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) ("Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning" (Clevenger, J. dissenting in part)).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

² See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

³ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 12-22 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara.⁴ It is the Examiner's principle position that the methods are anticipated because of the reasons stated above.

However, even if not anticipated, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogasawara to include the claimed method. Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be obvious in view of the disclosed structure as disclosed in claims 12-22.

12. Claims 1-11 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara. Because Invention I (claims 1-11) are not patentably distinct from Invention II (claims 12-22), the patentability of claims 1-11 with regards to Ogasawara stands or falls with the patentability of claims 12-22. See Paragraph 3, *supra*.

13. Functional recitation(s) using the word "for" (*e.g.* "for initiating and completing a commercial transaction" as recited in claim 12) have been considered but are given little patentable weight⁵ because they fail to add any structural limitations and are thereby regarded as

⁴ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

⁵ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

14. For due process purposes, the Examiner again confirms that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings. First and as noted in the previous Office Actions,⁶ the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in their specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements.⁷ Third, after

⁶ See the Office Action mailed April 23, 2003, Paper No. 9, Paragraph No. 16; and the Office Action mailed December 17, 2002, Paper No. 13, Paragraph No. 9.

⁷ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or

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receiving express notice of the Examiner's position that lexicography is *not* invoked,⁸ Applicant has not pointed out the "supposed errors" in the Examiner's position regarding *lexicography invocation* in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography *is* invoked). Forth and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁹ to be his own lexicographer.¹⁰ Finally, after receiving express notice of the preceding factual findings and conclusions, Applicant's latest response again does not point out the supposed errors in the Examiner's position regarding *lexicography invocation* in accordance with 37 C.F.R. §1.111(b). Moreover, Applicant's latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicant has decided not to be his own lexicographer. In fact, Applicant's response

otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁸ See the Office Action mailed April 23, 2003, Paper No. 9, Paragraph No. 16.

⁹ *Id.*

¹⁰ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed December 6, 2003).

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confirms that Applicant does not intend to be his own lexicographer.¹¹ Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with their “broadest reasonable interpretation,” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997),¹² and the Examiner continues to rely heavily and extensively on this interpretation.¹³

15. Although Applicant uses “means for” in the claim(s) (e.g. claim 12 recites “means for transferring and extracting encoded information”), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant concurs, the Examiner respectfully requests Applicant to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

¹¹ See Applicant’s Remarks in Paper No. 16, filed with Amendment ‘C’ June 24, 2003, Page 10, last full paragraph.

¹² See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification.”); MPEP §§ 2111 and 2111.01; and *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

¹³ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . [Emphasis added.]”

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Alternatively, if Applicant desires to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant to expressly state his desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th*.¹⁴

Failure by Applicant in his next response to also address the 35 U.S.C. 112 6th paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant NOT to invoke 35 U.S.C. 112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6th paragraph applies to all examined claims currently pending.

Response to Arguments

16. Applicant’s arguments filed with his amendment in Paper No. 16 have been fully considered but they are not persuasive.

17. Applicant principally argues that Ogasawara does “is not made for the purpose of completing a transaction and actually purchasing the items.” As noted in paragraph 15 from the previous Office Action (Paper No. 13):

Moreover, it is the Applicant—and not the Examiner—that drafted claim 12 as a system claim. “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, “[c]laims in

¹⁴ Federal Register Vol 65, No 120, June 21, 2000.

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apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner's position that Applicant(s)' system claims are clearly "product" "apparatus," or more specifically, "machine" claims. With this in mind, Applicant is reminded that "apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). In other words, claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function or actions. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

18. Applicant is reminded that apparatus claims give patent protection covering "all uses" for the claimed apparatus. *Augustine Medical, Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 50 USPQ2d 1900, 1908 (Fed. Cir. 1999). "Indeed, the inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not." *Catalina Marketing International Inc. v. Coolsavings.com Inc.*, 289 F.3d 801, 809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002) (citations and quotations omitted). For Applicant's product claims, "the purpose" of the claimed invention will not make the otherwise known structure novel or nonobvious. In other words, a new use or function of an old nonobvious product will not distinguish the claimed invention over the prior art. *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 162 (CCPA 1957) ("[T]he grant of a patent on a composition or a machine cannot be predicated on a new use of that machine or composition").¹⁵

¹⁵ See also *In re Zierden*, 411 F.2d 1325, 1328, 162 USPQ 102, 104 (CCPA 1969) ("[M]ere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable."); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to

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19. Additionally, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v. Faytex P*”). Furthermore, the Federal Circuit “acknowledges that it has in effect recognized . . . product-by-process claims as exceptional.” 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status and because Applicant is arguing the patentability of product claims 12-22 in terms other than structural characteristics (*i.e.* Applicant is arguing the “purpose” distinguishes his claimed invention from the prior art), there is a possibility that Applicant intends to claim product-by-process claims.

However, the Examiner has carefully reviewed claims 12-22 and it is the Examiner’s position that claims 12-22 *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicant disagrees with the Examiner, the Examiner respectfully requests Applicant in his next response to expressly point out any product-by-process claim(s) and their limitations (whether in a conventional format or otherwise) so that they may be afforded their exceptional status and treated accordingly. Applicant is reminded that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964,

claims to the known composition.”); and *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) (intended use of an old composition does not render composition claim patentable).

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966 (Fed. Cir. 1985) (citations omitted).¹⁶ Failure by Applicant in his next response to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered intent by Applicant *not* to recite any product-by-process limitations. Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

20. Regarding Barnett, Applicant argues that “*Barnett* is a system that is distinctly different than the Ogasawara reference.”¹⁷ Whether or not this is true does not diminish the fact that the Examiner has set forth a prima facie case since its Applicant’s *claims* to which the prior art is compared—not the other prior art.

21. Applicant also argues that “The Examiner had noted in Item 9 of the Office Action [Paper No. 13] that no patentable weight was given to functional language.”¹⁸ This statement is simply not true. The Examiner has not said that functional language is given “no patentable weight.” To be clear, all claim language must be considered, yet not all claim language is given patentable weight. *Gulack*. It is the legal effect of that claim language which appears to be in dispute. While ‘claim construction’ and ‘claim interpretation’ mean the same thing,¹⁹ Judge Newman’s

¹⁶ See also MPEP §2113.

¹⁷ Applicant’s Remarks in Paper No. 16, Page 9, last paragraph.

¹⁸ Applicant’s Remarks in Paper No. 16, Page 10, first full paragraph.

¹⁹ “The dissenting opinion draws a distinction between claim interpretation and claim construction based on the distinction made in contract law. We do not make the same distinction for, in our view, the terms mean one and the same thing in patent law.” *Markman v. Westview*

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classification is helpful since Applicant appears to argue that there is a disagreement ‘claim interpretation’ yet to the Examiner, it appears to be a disagreement of ‘claim construction.’ Nevertheless, the legal effect is that the “purpose” of the claims does not change claim the construction since, when interpreting functional language, if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Applicant’s popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference).

22. Finally, Applicant confirms on page 10 that he does not intend to be his own lexicographer. This is very important during ex parte examination because lexicography is one of two exceptions to the requirement²⁰ that the Examiner interpret the claims with the “broadest reasonable interpretation.”²¹ Lexicography would thus dramatically change the Examiner claim

Instruments, 52 F.3d 967, 975 n. 6 (Fed. Cir. 1995) (en banc)[hereinafter “Markman I”], *aff’d*, *Markman*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Judge Newman in *Markman I* disagreed and distinguished “claim interpretation” from “claim construction.” “Claim interpretation” she argued refers to the process of determining the meaning of the words used. “Claim construction” refers to their legal effect. *Id* at 100.

²⁰ “[A]n examiner has the duty to police claim language by giving it the broadest reasonable interpretation” *Spring Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 994, 65 USPQ2d 1826, 1830 (Fed. Cir. 2003) (citations omitted).

²¹ When applicants are their own lexicographer and successfully redefining a claim to have a meaning other than its ordinary and accustomed meaning, the claims must be examined using that meaning. See MPEP §2173.05(a) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320; 1322 (Fed. Cir. 1989) (“When the Applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the Applicant’s invention and its relation to the prior art.”).

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interpretations and in turn, profoundly affect the Examiner's prima facie case of anticipation and/or obviousness.

Conclusion

23. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

24. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety.

Moreover, because these three references are directed towards beginners (see *e.g.* "User Level Beginning . . ."), because of the references' basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the

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Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

25. It is the Examiner's factual determination that all limitations in the pending claims have been considered and are either disclosed or inherent in the references as discussed above.

Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

26. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (Paper No. 16 beginning on Page 7) traversing the Examiner's positions on various points. If Applicant disagrees with *any* additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,²² the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with

²² E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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37 C.F.R. §1.111(b) *in his next response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. To respond to this Office Action by facsimile, fax to (703) 872-9306.

Handwritten signature of Andrew J. Fischer and the date 12/8/03.

Andrew J. Fischer
Patent Examiner

AJF
December 8, 2003